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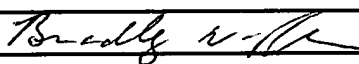
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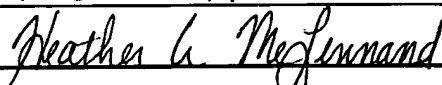
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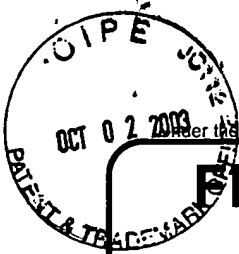
<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/543,951	
	Filing Date	6 April 2000	
	First Named Inventor	W.S. Dalton	
	Art Unit	3677	
	Examiner Name	Wm. L. Miller	
Total Number of Pages in This Submission	7	Attorney Docket Number	110TC-015A (1633-015A)

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to Technology Center (TC)
<input checked="" type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
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<input type="checkbox"/> Response to Missing Parts/Incomplete Application		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		
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<b>SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT</b>		
Firm or Individual name	Bradley N. Ruben, PC	
Signature		
Date	29 September 2003	

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Typed or printed name	Heather A. McLennand	
Signature		Date 29 September 2003

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# FEE TRANSMITTAL for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 280

## Complete if Known

Application Number 09/543,951

Filing Date 6 April 2000

First Named Inventor W.S. Dalton

Examiner Name W.L. Miller

Art Unit 3677

Attorney Docket No. 110TC-015A (6-00-015A)

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GROUP 3600

## METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number 502144

Deposit Account Name Bradley N. Ruben

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments

☐ Charge any additional fee(s) during the pendency of this application

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account. ☒ Any Fee Deficiencies

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	750	2001	375	Utility filing fee	
1002	330	2002	165	Design filing fee	
1003	520	2003	260	Plant filing fee	
1004	750	2004	375	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$ )

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims		Fee from below	Fee Paid
Total Claims	<input type="text"/>	-20** =	<input type="text"/>	X <input type="text"/>	= <input type="text"/>
Independent Claims	<input type="text"/>	-3** =	<input type="text"/>	X <input type="text"/>	= <input type="text"/>
Multiple Dependent				<input type="text"/>	= <input type="text"/>

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	84	2201	42	Independent claims in excess of 3	
1203	280	2203	140	Multiple dependent claim, if not paid	
1204	84	2204	42	** Reissue independent claims over original patent	
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) (\$ )

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	410	2252	205	Extension for reply within second month	
1253	930	2253	465	Extension for reply within third month	
1254	1,450	2254	725	Extension for reply within fourth month	
1255	1,970	2255	985	Extension for reply within fifth month	
1401	320	2401	160	Notice of Appeal	
1402	320	2402	160	Filing a brief in support of an appeal	
1403	280	2403	140	Request for oral hearing	280
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,300	2453	650	Petition to revive - unintentional	
1501	1,300	2501	650	Utility issue fee (or reissue)	
1502	470	2502	235	Design issue fee	
1503	630	2503	315	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	750	2809	375	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	750	2810	375	For each additional invention to be examined (37 CFR 1.129(b))	
1801	750	2801	375	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ ) 280

## SUBMITTED BY

Name (Print/Type) Bradley N. Ruben

Registration No. 32,058  
(Attorney/Agent)

(Complete if applicable)

Telephone 201-239-0707

Signature

Date 29 September 2003

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
before the  
Board of Patent Appeals and Interferences

#24  
878  
W/11/03

Appln. Ser. No.:	Filed:	Inventor(s):	Atty Dkt:
09/543,951	6 April 2000	W. Dalton <i>et al.</i>	110TC-015A (1633-015A)
Title: Improved Brush Seal Designs for Turbines and Similar Rotary Apparatus			
Examiner: M. Rogers			Art Unit: 3677

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REPLY BRIEF under § 1.193  
and  
REQUEST FOR ORAL HEARING under § 1.194

Dear Sir:

In complete and timely response to the Examiner's Answer mailed 29 July 2003, this Reply Brief is submitted.

Applicants also hereby request an Oral Hearing. A check for the \$280 fee under § 1.17(d) is attached. If the check is insufficient or missing, or if there has been an overpayment, please debit or credit as necessary Deposit Acct. 502144.

Reply to Examiner's "Response to Arguments"

There is a difference between combining the *functions* shown in the cited references and combining the *structures* shown in the cited references. The

Brandon and Bagepalli references are clearly both directed to sealing in a turbine environment, and while there *may* be motivation to provide “better” sealing, there is no motivation from the references to arrive at the claimed structure: merely combining separate sealing functions by the elements that execute those functions does not render obvious a specifically claimed structure that happens (from the Examiner’s point of view) to execute those separate sealing functions.

M3 Systems argued at trial that the patented needle assembly would have been obvious in light of the Tru-Cut needle assembly, and that the only differences arose from obvious adaptations to accommodate the new gun design and to provide the desired reverse movement of the needles. No other prior art was presented. The invention that was made, however, does not make itself obvious; that suggestion or teaching must come from the prior art. See, e.g., *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051-52, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (it is insufficient to select from the prior art the separate components of the inventor’s combination, using the blueprint supplied by the inventor); *Fromsom v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) (the prior art must suggest to one of ordinary skill in the art the desirability of the claimed combination).

No prior art provided a teaching or suggestion or motivation that a needle assembly should be made with the structure shown and claimed in the '056 patent. Absent this essential evidentiary component of an obviousness holding, as a matter of law the verdicts of invalidity on that ground can not stand. Consequently, the judgment of invalidity based on obviousness is reversed.

*C.R. Bard Inc. v. M3 Systems Inc.*, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)  
(underlined emphases added).

The Answer alleges that “the Bagepalli reference need only teach the incorporation of a brush seal into the labyrinth seal wherein the brush seal ends are cut non-parallel with the radii of the shaft” (emphases added). Such arguments are the “picking and choosing” of aspects of the art necessary to the rejection, but legally impermissible. *In re Wesslau*, 147 USPQ 391 (C.C.P.A. 1965), and the cases cited in the above-quoted material.

There is no suggestion in any individual prior art reference of such a combination of location and configuration nor is it suggested by the prior art as a whole. *Interconnect Planning Corp.*, 774 F.2d at 1143, 227 USPQ at 551; *see also W.L. Gore & Assocs.*, 721 F.2d at 1551, 220 USPQ at 312 (it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention).

*Uniroyal Inc. v. Rudkin-Wiley Corp.*, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988).

In the present case it is the combination and location between and among the seal segments and the brush seals and the ends of each with respect to the radius orthogonal to the shaft that is not suggested in the art. With regard to the Sulda declaration, the Examiner may not judge such evidence as “irrelevant” (Answer at page 7, line 17) because of the way in which the rejection is framed. *In re Katzschmann*, 146 USPQ 66, 68 (CCPA 1965) (declaration attesting to facts must be considered in final obviousness determination); *In re Fay*, 146 USPQ 47, 51 (CCPA 1965) (even a mere opinion is entitled to consideration). The Examiner has provided no evidence under § 1.104(d)(2) regarding possession of any special personal knowledge in this technology. In contrast, the declarants in this case have attested to their knowledge and experience in this field, and so

their opinions about the functioning of the prior art devices cannot be ignored as "irrelevant."

By the reasoning in the Examiner's Answer, the mere citation of structure in a reference that also appears in the rejected claims is un rebuttable because the reference is being used "solely for" some allegedly limited teaching. (Answer at In. 18.) Such a standard is contrary to the fundamental requirement set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 456 (1966), requirements to investigate the scope and content of the prior art and the differences between the claimed invention and the cited art. Taking 'only so much' of the cited art as is necessary to make the rejection ignores the fact that the content of Bagepalli is directed to stationary, non-retractable seals, and that fact is a difference that must be considered in its combination with Brandon and with respect to the claimed invention.

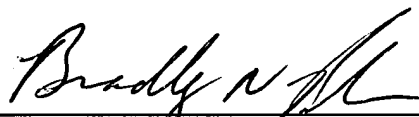
Sulda's declaration goes directly to that content and those differences by showing how the structure of the Bagepalli reference, as a whole, presents problems in the combination of references. That Bagepalli does, in fact, disclose a non-retractable seal is content that is different from the claimed invention. Bagepalli also discloses the circumferential offset that the Sulda declaration explains almost certainly prevents such a structure from being used as a retractable seal. The structural differences between Bagepalli and either Brandon or the claimed device are, according to *Graham*, necessarily relevant. To allow using a reference "solely for" a particular teaching without reference to the whole of the reference and the context of that teaching creates an

unrebuttable picking and choosing of only so much of the reference as supports the rejection. *In re Wesslau*, 174 USPQ 391 (C.C.P.A. 1965).

Finally, with regard to claim 6, the claim language clearly recites that the inner and outer faces and the T-shaped extension *span between two ends*, and the "tongue extend[s] past the segment side [end]." Applicants' tongue thus extends past the end of the entire segment, whereas the Bagepalli "tongue" analogous structure is always within some outermost side portion (the "end") of the Bagepalli segment. That is, the "axially-tapered" end 70 in Bagepalli does not extend past end 48, whereas the present claims require that the claimed "tongue" 303 have such an extension past the end 203a (in Applicants' Figs. 2A and 3).

In light of the foregoing, all of the rejections should be reversed.

Respectfully submitted,



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29 September 2003

**CERTIFICATE OF MAILING OR  
TRANSMISSION – 37 CFR 1.8**

I hereby certify that I have a reasonable basis that this paper, along with any referred to above, (i) are being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, or (ii) are being transmitted to the U.S. Patent & Trademark Office in accordance with 37 CFR § 1.6(d).

DATE: Sept 29, 2003

NAME: Heather A McLennand

SIGNATURE: Heather A McLennand